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REPLY BRIEF UNDER 37 C.F.R. § 41.41(a)(1)
TECHNOLOGY CENTER ART UNIT 2143

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:
RAYMOND F. RATCLIFF III
Serial No.: 09/818,003
Filing Date: March 27, 2001

Confirmation No.: 2031
Art Unit: 2143
Examiner: SHIN, KYUNG

Title: METHOD AND APPARATUS FOR SHARING INFORMATION USING A
HANDHELD DEVICE

December 23, 2006

REPLY BRIEF

COMMISSIONER FOR PATENTS
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This is a Reply Brief to the Examiner's Answer of November 1, 2006. This Reply Brief is filed under 37 C.F.R. § 41.41, and is accompanied by the required fee.

A. STATUS OF CLAIMS

Claims 1-41 and 45-52 are currently pending with claims 1, 12, 16, 22, 30, 34, 38, 45, 47, 48 and 49 being independent.

The Final Rejection of claims 1-41 and 45-52 is appealed.

Appellant filed a response to the Final Office Action of December 20, 2006 on March 20, 2006. In the response to the Final Office Action, claim 16 was amended and claims 42-44 were cancelled. In the Advisory Action mailed on April 18, 2006, the Examiner indicated that for purposes of Appeal, the amendments filed on March 20, 2006 will be entered.

B. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The issues in this Appeal are whether:

1. Claims 1, 2, 7-9, 12-19, 21-23, 30, 31, 33-41 and 45-52 are unpatentable under 35 U.S.C. § 103(a) over Eldridge et al. (U.S. Patent No. 6,515,988) in view of Neukermans et al. (U.S. Patent No. 6,229,139).
2. Claims 3-6 and 24-27 are unpatentable under 35 U.S.C. § 103(a) over the combination of Eldridge et al. and Neukermans et al. and further in view of Hayakawa (U.S. Patent No. 6,765,559).
3. Claims 10, 20, 28 and 32 are unpatentable under 35 U.S.C. § 103(a) over the combination of Eldridge et al. and Neukermans et al. and further in view of Browning (U.S. Patent No. 6,707,781).
4. Claims 11 and 29 are unpatentable under 35 U.S.C. § 103(a) over the combination of Eldridge et al. and Neukermans et al. and further in view of Hochendoner (U.S. Patent No. 6,771,568).

C. ARGUMENTS

C1. Rejection of claims 1, 2, 7-9, 12-19, 21-23, 30, 31, 33-41 and 45-52 as being unpatentable under 35 U.S.C. § 103(a) over Eldridge et al. (U.S. Patent No. 6,515,988) in view of Neukermans et al. (U.S. Patent No. 6,229,139).

C1.1. Claims 1, 2, 7-9, 45 and 46

In page 28 of the Examiner's Answer, the Examiner points to page 10, lines 15-19 and page 11, lines 16-22 of the Appeal Brief and states that "[t]here was no indication that the stated tokens indicated in Eldridge are to be replaced by 'document data.' The Eldridge and Neukermans combination merely adds the scanned 'document data' and conversion into digital data feature from Neukermans to Eldridge. Eldridge's token will include the document data, which is additional identification parameter within the token, and is transmitted to a document server in order to complete one of the principal functions of Applicant's invention, which is document identification."

The Examiner appears to have ignored a portion of Appellant's argument in the Appeal Brief. Specifically, in the Appeal Brief, in addition to arguing the lack of suggestion in Eldridge to replace the tokens with actual document data, Appellant also argues that there is no suggestion in Eldridge to add actual document data to the tokens.

In page 29 of the Examiner's Answer, the Examiner states that "[a] document can be identified merely by a passage of that document. '*Call me Ishmael*' from Moby Dick, or '*It is a far, far better thing that I do, than I have ever done*' from A Tale of the Two Cities. Mention these passage [sic] and any knowledgeable individual can identify the document. Clearly, a passage or a set of document data (i.e. actual data from a document) can be utilized to identify a document. To utilize this concept on a larger scale using IT resources at the time of applicant's invention would be considered obvious to one skilled in the art."

In the above statement, the Examiner is taking an Official Notice that the concept of identifying a document from a passage or set of document data using IT resources would be considered obvious. First of all, this is a new ground of rejection that the Appellant has not seen before during the prosecution of this case. In addition, the Examiner did not provide any documentary evidence for the argument that it would have been obvious to utilize IT resources to identify a document from a passage or a set of document data.

"It would not be appropriate for the examiner to take official notice of facts without citing

a prior art reference where the facts are asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.” (see, MPEP 2144.03 A). “If the examiner is relying on personal knowledge to support the finding of what is known in the art, the Examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding.” (see, MPEP 2144.03 C).

In the present case, the Examiner asserts that “any knowledgeable individual” would identify a document from a passage of the document. The Examiner gives two examples to support this assertion. However, the present claimed invention does not require that a user has to be “knowledgeable” of the source of the data in the document to be able to identify the document. The identification of the document is performed by using “a data processing apparatus.” The Examiner contends that to use the concept of identifying a document from a passage or a set of document data (i.e. actual data from a document) on a larger scale using IT resources would be considered obvious to one skilled in the art. The Examiner, however, failed to provide any concrete evidence to support this contention.

In page 30 of the Examiner’s Answer, the Examiner asserts that “[t]he proposed combination would not destroy the Eldridge prior art. (see Appeal Remarks Page 11, lines 4-6) It would be advantageous by adding a new and very useful feature to the Eldridge prior art. Adding an additional identification parameter would only enhanced [sic] the capabilities of the Eldridge prior art.” Appellant respectfully disagrees.

The combination of Neukermans and Eldridge would destroy the apparatus of Eldridge for its intended purpose. The Examiner contends that the combination of Neukermans and Eldridge would add an “additional identification parameter.” However, as stated in page 11 in the Appeal Brief, even if Neukermans and Edridge are combined, which Appellant does not concede, the combination would merely allow the portable device in Eldridge to transmit the scanned document data (of Neukermans) with the token of Eldridge to another device (e.g., a printer) and thus destroy the purpose of Eldridge which is to transmit tokens (document identifiers) instead of the documents themselves.

Furthermore, in page 30 of the Examiner’s Answer, the Examiner states “[I]t has been established that actual data from a document can be used for identification purposes and that this fact is obvious to anyone skilled in the art.” Here, the Examiner is once again taking Official Notice without providing documentary evidence that actual data from a document can be used for identification purposes.

Therefore, in view of the above remarks and in view the remarks filed in the Appeal Brief, it is respectfully requested that the rejection of claims 1, 2, 7-9, 45 and 46 under 35 U.S.C. § 103(a) over the combination of Eldridge et al. and Neukermans et al. be reversed.

C1.2. Claims 12, 13, 30, 48 and 49

In page 31 of the Examiner's Answer, the Examiner apparently agrees that Neukermans does not disclose comparing scanning data, the Examiner contends, however, that "Eldridge disclose the comparison function which is equivalent to identification of a document. The results of the comparison identify a particular document. The Eldridge and Neukermans combination performs the required capture and scanning data and subsequent comparison." Appellant respectfully disagrees.

As stated in page 14 of the Appeal Brief, Eldridge states that "the token contains the information necessary to find a document or service..." and as stated in page 15 of the Appeal Brief, the scanned document data in Neukermans is merely parsed, stored and archived.

There is no suggestion in either Eldridge, Neukermans or in the knowledge generally available to one of ordinary skill in the art to modify Eldridge using Neukermans to scan a document and generate data which can be used for comparison and identification. In Neukermans, the scanned data is merely parsed, stored and archived. The scanned data is not used for comparison identification. Furthermore, there is no suggestion in either Eldridge, Neukermans or in the knowledge generally available to one of ordinary skill in the art to "add" the scanned document data of Neukermans to the token of Eldridge and generate digital data that can be used for comparison identification.

Therefore, in view of the above remarks and in view of the remarks filed in the Appeal Brief, it is respectfully requested that the rejection of claims 12, 13, 30, 48 and 49 under 35 U.S.C. § 103(a) over the combination of Eldridge et al. and Neukermans et al. be reversed.

C1.3. Claim 14, 18, 40

In pages 32 and 36 of the Examiner's Answer, the Examiner states that "[t]he Eldridge et al. prior art disclose parameters utilized to specify a particular document. The author of a document is a parameter utilized to identify a particular document." Appellant respectfully disagrees. Claims 14, 18 and 40 require that the received document data includes digital text data identifying an author. The mere disclosure in Eldridge of a token containing service names,

which identify how a service is identified to the user, is not equivalent to “an author.” The Examiner is reading the claims 14, 18 and 40 to be broader than their respective limitation(s).

Therefore, in view of the above and in view of the remarks filed in the Appeal Brief, it is respectfully requested that the rejection of claims 14, 18 and 40 under 35 U.S.C. § 103(a) over the combination of Eldridge et al. and Neukermans et al. be reversed.

C1.4. Claim 15, 19, 41

In pages 33 and 37 of the Examiner’s Answer, the Examiner states that “[t]he Eldridge et al. prior art disclose parameters utilized to specify a particular document. The publication date of a document is a parameter utilized to identify a particular document.” Claims 15, 19 and 41 require that the received document data includes digital text data identifying a publication date. The mere disclosure in Eldridge of a token containing service names, which identify how a service is identified to the user, is not equivalent to “a publication date.” The Examiner is reading the claims 15, 19 and 41 to be broader than their respective limitation(s).

Therefore, in view of the above and in view of the remarks filed in the Appeal Brief, it is respectfully requested that the rejection of claims 15, 19 and 41 under 35 U.S.C. § 103(a) over the combination of Eldridge et al. and Neukermans et al. be reversed.

C1.5. Claim 50, 51 and 52

In pages 33, 34 of the Examiner’s Answer, the Examiner states that “[t]he Eldridge et al. prior art disclose parameters utilized to specify a particular document. The name of a publication of a document is a parameter utilized to identify a particular document.” Claims 50, 51 and 52 require that the received document data includes digital text data identifying a name of a publication. The mere disclosure in Eldridge of a token containing service names, which identify how a service is identified to the user, is not equivalent to “a name of a publication.” The Examiner is reading claims 50-52 to be broader than their respective limitation(s).

Therefore, in view of the above and in view of the remarks filed in the Appeal Brief, it is respectfully requested that the rejection of claims 50-52 under 35 U.S.C. § 103(a) over the combination of Eldridge et al. and Neukermans et al. be reversed.

C1.6. Claims 16, 17, 21, 31, 33, 38, 39 and 47

In pages 34-36 of the Examiner’s Answer, the Examiner states “Applicant uses the term

“fetches”, it is unclear how this term is used since the term does [sic] appear in the prior art.” As clearly stated in pages 17 and 19 of the Appeal Brief, the user at the first machine simply “fetches” the document from the second machine without using the address of the user.

Appellant refers to col. 5, lines 14-17 in Eldridge et al. where it is stated “[u]pon request of a user at a first machine, a document on a second machine may be retrieved and sent from the second machine over the internet.” One of ordinary skill in the art would understand when reading this sentence that the word “retrieve” is synonym with the word “fetch.” Clearly, fetching/retrieving a document is different from sending the document using an address.

Therefore, in view of the above and in view of the remarks filed in the appeal Brief, it is respectfully requested that the rejection of claims 16, 17, 21, 31, 33, 38, 39 and 47 under 35 U.S.C. § 103(a) over the combination of Eldridge et al. and Neukermans et al. be reversed.

C1.7. Claims 22, 23 and 34-36

The Examiner’s response in page 38 of the Examiner’s Answer is addressed in the above paragraphs and in the Appeal Brief.

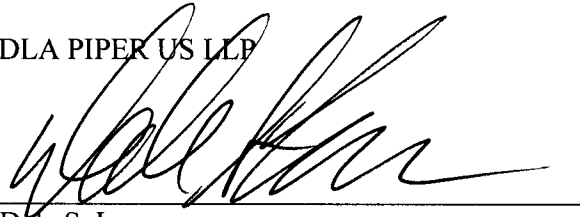
D. CONCLUSION

Appellant stands by all of the arguments presented in his Appeal Brief for each of the rejections.

For each of the reasons set forth in Appeal Brief and for each of the foregoing reasons, it is submitted that there is no *prima facie* case of obviousness. Appellant has rebutted all such obviousness rejections. Accordingly the Final Rejection should be reversed in all respects.

Respectfully submitted,

DLA PIPER US LLP

A handwritten signature in black ink, appearing to read 'Dale S. Lazar', is written over a horizontal line.

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